

**REMARKS**

The claimed method is one for measuring certain electrical activity emanating from muscle or neural tissue samples in response to applied chemical substances. This method is suitable for measuring such activity both on a short term basis and on a chronic or longer term basis.

As a preliminary matter, it should be made clear that by presenting the amendments made here, Appellants are not in any way acquiescing in or agreeing to the substance of any rejection or objection stated in the Final Rejection. The claims were patentable in the form presented on appeal and the claims are patentable in the form now-presented.

In particular, removal of the word "chronic" broadens the claims in a way that includes time spans of all kinds -- whether in the "chronic" time frame or not. As Appellants have noted before on many occasions, the term "chronic" is an adjective that is relative and comparative in nature and that is widely used and readily understood in the "ordinary meaning" context favored by the U.S. Court of Appeals for the Federal Circuit for construing the meaning of terms found in claims.

Similarly, substitution of "complete electrical waveform" into the claim, although that term is physically larger, introduces a term that recites, in effect, the same limitation as previously found in the claims. That previous limitation required that the "electrical properties of the neural or muscle tissue sample" be measured. Those electrical properties were waveforms. Typical waveforms are shown by the Appellants, *inter alia*, in the Figures. The contact of the tissue sample with some number (e.g., a plurality) of electrodes to allow detection of electrical activity in the tissue sample provides the user with a powerful tool. The user may choose for measurement and subsequent comparison, any or all of the available activity, for instance, such selected activity may be activity selected by regions of the sample or by types of observed electrical waveforms such as spikes or sinusoidal or other selected waveforms. Similarly, the claimed process includes variously, direct comparison of measured electrical activity and indirect comparison of

electrical activity information as it may be derived or calculated from that measured activity.

As a final matter, the amended claims are patentable over the references discussed in the Appeal Brief for the same reasons as found there. None of the Gahwiler et al or Gross et al or Giaver et al references show a procedure for placement of a tissue sample on a multi-electrode array to measure electrical properties or activity or waveforms from that tissue.

Allowance is requested.

**SUMMARY**

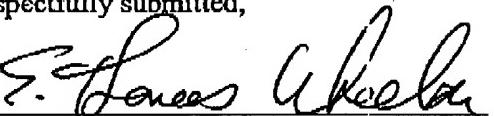
Appellants have amended the claims and explained the scope and meaning of the amendments. Allowance is requested.

In the unlikely event that the USPTO determines that an extension or other relief is required as a result of this document, Appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and other fees due to our Deposit account no. 03-1952 referencing Docket No. 356972020100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: May 5, 2004

By:



E. Thomas Wheelock  
Registration No. 28,825

Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
Telephone: (650) 813-5674  
Facsimile: (650) 494-0792